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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,184	05/18/1999	KANAME MIWA	Q54404	3561

7590

02/12/2003

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EXAMINER

TUNG, TA HSUNG

ART UNIT

PAPER NUMBER

1753

DATE MAILED: 02/12/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.



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Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run \_\_\_\_\_ or continues to run 3 months from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 1-21-03 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
  - ☐ They raise new issues that would require further consideration and/or search. (See Note).
  - ☐ They raise the issue of new matter. (See Note).
  - ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☒ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: none  
Claims objected to: none  
Claims rejected: 16-20, 22-24, 30-35 (all)

However;

☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because \_\_\_\_\_

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

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Because the proposed amendment of Jan. 21, 2003 broadens some claims, upon entry of the amendment the final rejection would be re-formed as follows:

- 1) Claims 16-20, 22-24, 30-35 would be rejected under 35 USC 102(a) as being anticipated by Kato et al 5,672,811.
- 2) Claims 19, 20, 31 would be rejected under 35 USC 103(a) as unpatentable over Kato et al '811.
- 3) Claim 33 would be rejected under 35 USC 103(a) as unpatentable over Kato et al '811 in view of Yagi et al 5,384,630.
- 4) Claims 32-35 would be rejected under 35 USC 112, second paragraph.

In regard to the prior art rejections, applicant argues that Kato does not disclose in the description or the drawings what are the widths of the electrodes 28, 24. The examiner is not entitled to presume that the electrodes' width are equal. Without that knowledge, there is no way to ascertain whether the areas of electrodes have a ratio within the range claimed by applicant.

This argument is not persuasive. First, Kato does not in any way indicate that his electrodes are of varying widths. If they were, Kato presumably would have shown such a configuration in a figure. Second, it is clear from figure 1 that the chambers (8, 10) which house the electrodes 28, 24 are elongated. The widths of the chambers are substantially smaller than their lengths. The electrodes, then, can not extend much in a width direction, and any variance in the electrodes' width would be quite small compared to the electrodes' lengths. Since area is


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length times width, the ratio of the areas would still be within the 2:1 to 5:1 ratio claimed by applicant even if the electrodes' widths varied.

As for the 112) rejection, applicant argues that the means-plus-function terminology employed by claims 32-35 call for different circuits and thus renders the claims patentably distinct.

This argument is not persuasive. Since difference in voltage values can often be provided by merely adjusting a variable resistance to different settings, applicant's claims are not considered to recite actually different circuits. This is especially true when the voltage ranges called for by applicant overlap. For example, if the voltage value is set at 0.4 V, what is the difference between the apparatus recited in claim 32 and the apparatus recited in claim 34? Similarly, if the voltage value is set at 1.1 V, what would be the difference between the apparatuses of claims 33 and 33?

The examiner can be reached at 703-308-3329. His supervisor Nam Nguyen can be reached at 703-308-3322. Any general inquiry should be directed to the receptionist at 703-308-0661. A fax number for TC 1700 is 703-872-9311.

  
Ta Tung

Primary Examiner

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